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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,389	02/10/2004	Daniel Scott Venolia	4860P0539D4	3938
8791 7590 03/20/2007 BLAKELY SOKOLOFF TAYLOR & ZAFMAN 12400 WILSHIRE BOULEVARD SEVENTH FLOOR LOS ANGELES, CA 90025-1030			EXAMINER BRIER, JEFFERY A	
			ART UNIT	PAPER NUMBER
			2628	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/20/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/776,389

Applicant(s)

VENOLIA, DANIEL SCOTT

Examiner

Jeffery A. Brier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-81 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26-81 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/18/2006 has been entered.

Response to Amendment

2. The amendment filed 12/18/2006 has been entered. The amendments to claims 41, 52, 56, and 60 concerning the use of the phrase "first control element of a graphical user interface" and "second control element of a graphical user interface" overcomes the 35 USC 112 second paragraph rejection based upon this issue. The 35 USC 112 second paragraph rejection of claim 63 has not been overcome because at line 12 "second control element" was not changed to "second interface element". The amendment to claims 26, 31, and 36 concerning the use of the phrase "wherein the adjusting the first parameter causes a parameter under control of another user interface element of the graphical user interface to be adjusted based on a value of the first parameter" overcomes the 35 USC 112 first paragraph rejection based upon this issue.

Response to Arguments

3. Applicant's arguments filed 12/18/2006 have been fully considered but they are not persuasive.

Applicants arguments at pages 17-19 concerning the issue raised in paragraphs 5 and 8 in the Final rejection mailed on 9/14/2006 are not persuasive because: at pages 17-18 applicant makes reference to and quotes page 4 lines 2-9 which describes providing a user with control over a broad range of data by utilizing a cursor positioning device which implies the device controls a cursor; at page 18 applicant makes reference to and quotes page 5 lines 3-13 which describes remapping of the axes from cursor control to scale and range control but does not describe controlling only the scale and range with the cursor positioning device; and at page 19 applicant makes reference to the paragraph starting at page 13 line 25 which is describing the prior art method of placing a cursor over control knob 16, depressing and keep depressing the mouse button while moving the mouse in the vertical direction will cause the scale of the timeline 14 to change which is in contrast with the disassociating the mouse from the cursor described in the following paragraph starting at page 14 line 4. Contrary to applicants arguments the specification does not describe a way for a mouse or other cursor positioning device to control the scale and range at the same time without disassociating or remapping the mouse or other cursor positioning device from the cursor. Independent claims 26, 31, 36, 52, 56, 60, 63, each claim changing the scale and range by controlling elements of a graphical user interface and claims 64, 70, and 76 claim changing the first parameter and second parameter by controlling elements of

a graphical user interface. The specification does not disclose any method of controlling elements of a graphical user interface without disassociating or remapping the mouse or other cursor positioning device from the cursor. The embodiment described in the paragraph starting at page 13 line 25 can control only the scale. Thus, applicants arguments are not persuasive.

Therefore, the remapping needs to be claimed in claims 26-81 since no other methods of performing the claimed "while a cursor of the graphical user interface is outside of first region on the display device" found in claim 26 lines 3-4, claim 31 lines 5-6, and claim 36 lines 4-5, the claimed "changing simultaneously the scale while moving the range over different portions of the data field" found in claim 41 where the range and scale are displayed by a respective interface element of the graphical user interface, the claimed "decreasing the scale ... while simultaneously moving the range" of claim 52 where the range and scale are displayed by a respective interface element of the graphical user interface, the claimed "simultaneously selecting the scale while moving the range over different portions of the data field" found in claim 56 where the range and scale are displayed by a respective interface element of the graphical user interface, the claimed "selecting a position of access... according to input form the input device with relation to a second axis ... of the input device while the first degree freedom of the input device controls said selecting the scale" where the range and scale are displayed by a respective interface element of the graphical user interface, the claimed "selecting a position of access... according to input form the input device with relation to a second axis ... of the input device while the first degree freedom of the input device controls

said selecting the scale” found in claim 60 where the range and scale are displayed by a respective interface element of the graphical user interface, the claimed “selecting a scale ...the scale being controlled by a first degree of freedom on a input device in a first interface element of a graphical user interface” and “moving the data field ... said moving controlled by a second degree of freedom of the input device in a second control element of the graphical user interface while the first degree of freedom of the input device controls the first interface element” found in claim 63 where the scale and moving the data field are controlled with respect to first and second interface elements of the graphical user interface, and the claimed “performing simultaneously” and “adjusting continuously” in association with a graphical user interface of claims 64, 70, and 76 is discussed by applicants specification.

The remapping of these claims due to the claiming of graphical user interface needs to correlate to the remapping discussed at applicants specification at page 18 line 21 to page 20 line 22.

Specification

4. The disclosure is objected to because of the following informalities: at page 18 line 27 a typographical error exists where “keeps tit depressed” should be changed to “keeps it depressed”.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 31-35 and 70-75 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. These claims claim "machine readable medium" and "machine readable instructions" while the "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility published on the USPTO website on October 26, 2005,

http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf

, see pages 52-54, and published in the OG 22Nov2005

<http://www.uspto.gov/web/offices/com/sol/og/2005/week47/patgupa.htm>) and in view of MPEP 2106I, see page 2100-18, all refer to "computer-readable media" and "computer-readable medium" and do not refer to machine readable media. Thus, applicant is claiming an invention that does not fall within the guidelines of statutory subject matter.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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8. Claims 31-35 and 70-75 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. These claims claim "machine readable medium" and "machine readable instructions". The specification does not use the words machine which is broader than computer and does not describe "machine readable", "machine readable instructions", and "causing a machine ... to implement a graphical user interface". Thus, the originally filed specification of parent application (07/811,830) does not convey that applicant had possession of "machine readable medium".

9. Claims 26-81 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Remapping of the mouse from cursor control to parameter control is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). Applicants specification describes a displayed graphical user interface where mouse X and Y movement controls cursor X and Y location and where after the mouse X and Y movements are remapped, the cursor is no longer controlled by mouse movements. When the cursor is decoupled from mouse movements then diagonal X and Y movement of the mouse will simultaneously adjust the scale and the position of the access to the data at the selected scale. Thus, the claimed limitations in

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claims 26-40 "first component", "second component", and "adjusting a first parameter ... the graphical user interface according to the first component of the input", the claimed limitation in claims 41-51 "changing simultaneously the scale while moving the range over different portions of the data field", the claimed limitation in claims 52-55 "decreasing the scale ... while simultaneously moving the range", the claimed limitations in claims 56-59 "simultaneously selecting the scale while moving the range over different portions of the data field", the claimed limitations in claims 60-62 "selecting a position of access... according to input from the input device with relation to a second axis ... of the input device while the first degree freedom of the input device controls said selecting the scale", the claimed limitations in claim 63 "moving the data field ... said moving controlled by a second degree of freedom of the input device in a second control element of the graphical user interface while the first degree of freedom of the input device controls the first interface element", and the claimed limitations in claims 64-81 "performing simultaneously" and "adjusting continuously" now more clearly claim that a graphical user interface is interacted with by the user to control the resolution of the range and the position in the range. According to the specification at page 4 lines 2-9, page 5 lines 3-13, page 11 lines 6-23, page 12 lines 6-23, page 13 lines 1-11, page 14 lines 4-16 and 26-31, page 17 lines 14-25, and page 19 lines 1-8 and 20-26 this can only be performed after the mouse movement is remapped from cursor control to controlling the claimed parameters. This is essential because applicant did not describe how in a graphical user interface environment to simultaneously control two parameters controlled by the graphical user interface without remapping the mouse from cursor

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control to parameter control. The remapping of these claims due to the claiming of graphical user interface needs to correlate to the remapping discussed at applicants specification at page 18 line 21 to page 20 line 22. See MPEP § 2172.01 and MPEP § 2164.08(c). Also note LizardTech Inc. v. Earth Resource Mapping Inc., 76 USPQ2d 1724 (Fed. Cir. 2005) and Lizardtech Inc. v. Earth Resource Mapping Inc., 77 USPQ2d 1391 (Fed. Cir. 2006). Dependent claims 50, 57-59 and 62 do not clearly claim the remapping described in the specification.

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 50, 57, 62, 63, 65-67, 71-73, and 77-79 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 50:

It is not clear in the claim the effect the icon of claim 50 has on the first interface element or the second interface element of claim 41. According to the specification when the cursor is positioned over one of the arrow icons 32 or 33, see specification at page 18 lines 25-28, page 19 lines 1-9, and page 20 lines 3-6, and when the button is depressed and continued to be depressed along with horizontal movement of the mouse the indicator 13 (first or second interface element of claim 41) remains stationary. When this happens the first or second interface elements would not display the scale or range. Additionally it is not clear from the claim if continued depressing of

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the button is required as discussed at page 18 lines 25-28. Thus, the metes and bounds of this claim is unclear.

Claim 57:

The function claimed does not clearly claim remapping because the switching conveyed by the claim is just a response to the user positioning the cursor over the interface element and controlling the interface element's parameter, however, according to the specification at page 18 lines 25-28 and page 19 lines 1-9 the switching is different than is currently claimed. Thus, the metes and bounds of this claim is unclear.

Claim 62:

The function claimed does not clearly claim remapping because the claimed remapping conveyed by the claim is the user positioning the cursor over the interface element and controlling the interface element's parameter, however, according to the specification at page 18 lines 25-28 and page 19 lines 1-9 the remapping is different than is currently claimed. Thus, the metes and bounds of this claim is unclear.

Claim 63:

Claim 63 uses the phrase "second control element of a graphical user interface". The original specification did not use the term "control element". Therefore, it is not clear what part of the graphical user interface is the "control element". The amendment to claim 63 does not overcome this issue because at line 12 "second control element" was not changed to "second interface element".

Claims 65-67, 71-73, and 77-79:

Each of independent claims 64, 70, and 76 claim "performing simultaneously" while dependent claims 65, 71, and 77 claim when a cursor is in the first region the first user element is controllable and when a cursor is in the second region the second user element is controllable. Thus, in claims 65, 71, and 77 it is not clear how the first and second parameters are adjusted simultaneously when the cursor can only control one of the first and second parameters.

12. Claims 26-81 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. For the reasons given above under 35 USC 112 first paragraph these claims are incomplete because they fail to claim the above described essential subject matter. This subject matter is essential because applicant did not describe how in a graphical user interface environment to simultaneously control two parameters controlled by the graphical user interface without remapping the mouse from cursor control to parameter control.

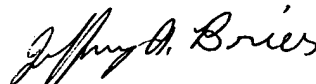
13. A prior art rejection and/or double patenting rejections with the parent patents (6,061,062; 6,366,303; 6,778,195) cannot be made because the metes and bounds of the claims are not definite and because the specification does not support the claims. Thus, an indication of allowability would be premature. In re Steele, 305 F.2d 859,134 USPQ 292 (CCPA 1962) (it is improper to rely on speculative assumptions regarding

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the meaning of a claim and then base a rejection under 35 U.S.C. 103 on these assumptions).

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffery A Brier whose telephone number is (571) 272-7656. The examiner can normally be reached on M-F from 7:00 to 3:30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Razavi, can be reached at (571) 272-7664. The fax phone Number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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